

### **Remarks/Arguments**

Claims 37-62 are pending in this Application. In the Office Action mailed January 20, 2006, the Examiner:

- withdrew Claims 60 and 61 for being drawn to a non-elected invention;
- rejected Claims 56 under 35 U.S.C. § 112, first paragraph, for not complying with the written description requirement;
- rejected Claims 37-55, 57-59 and 62 under 35 U.S.C. § 103(a) as being unpatentable over Benefiel (U.S. Patent No. 5,100,732).

Applicants respectfully address the restriction and rejections below and introduce new Claims 63-75, claims believed necessary to adequately protect Applicants' invention. Applicants further submit amended Claims 37, 41-46, 57, 60 and 62, amended as to matters of form, to provide proper antecedent basis where appropriate and/or to adequately protect Applicants' invention. Support for the new claims may be found throughout the specification, for example, see paragraphs [0003], [0012], [0018], [0019], [0020], [0021] and [0022]. Applicants submit that new Claims 63-75 do not introduce new matter and are patentably distinct over the cited art. Accordingly, Applicants respectfully request entry and allowance of new Claims 63-75.

### ***Election/Restriction***

In numbered paragraph 3 of the Office Action, the Examiner stated, "Claims 60 and 61, drawn to a coil of material, are grouped with the invention of non-elected Claims 1-36 and, thus, are withdrawn from further consideration in this application." Applicants respectfully disagree with the Examiner statement, pointing out the reason for restriction, as stated by the Examiner in the Office Action mailed December 13, 2004, and provided below.

"Invention I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, (MPEP § 806.04(b), 3<sup>rd</sup> paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a flat product (e.g., a floor mat or poster board) and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, application should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the

record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.”

Applicants respectfully points out that Claims 60 and 61 as amended as well as new Claims 68-75 are obvious variants of the elected invention, provided as amended Claims 37, 57 and 62. For example, neither independent and amended Claim 60 or new Claim 68 can be construed as intermediate products useful to make other than the final product nor are such claims patentably distinct species of pending Claims 37-59 and 62. For example, amended Claim 60 and new Claim 68 are not useful for other products than channel letter coils and there is nothing on the record to show them to be anything but obvious variants of the elected invention, as they are drawn to related inventions. Should the Examiner disagree, Applicant respectfully requests evidence be provided as to how such claims may not be obvious variants of the claims elected for prosecution.

***Claims Rejection under 35 U.S.C. § 112, first paragraph***

In numbered paragraph 5 of the Office Action, the Examiner stated that Claim 56 contained subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner further stated, “the specification does not make clear how the second material would be disposed upon the first material if both materials are disposed in a single step. Applicants submit that a patent specification must only describe that which is not conventional in the art or known to one of ordinary skill in the art. Applicant submits that such a step as claimed in Claim 56 is conventional in the art and one of skill in the relevant art would be apprised of and know how a second material and first material may be disposed in a single step. Applicant further submits that the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize this as defined by Claim 56. Accordingly, Applicants submit that Claim 56 is adequately described in the specification as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention.

***Claims Rejection under 35 U.S.C. § 103(a)***

In numbered paragraph 6 of the Office Action, the Examiner rejected Claims 37-55, 57-59 and 62 under §103(a) as being unpatentable over Benefiel. Applicants respectfully submit that Benefiel does not teach or suggest each and every element of independent and amended Claims 37,

57, 60 or 62, nor the claimed inventions as a whole. For example, with respect to amended Claim 57, Benefiel does not teach or suggest providing a substrate having a first and second surface, the first surface being an inner surface of the substrate; disposing a first material upon the first surface of the substrate, wherein the first material comprises a thermo-set polyester with a highly reflective surface; disposing a second material upon the first material, wherein the second material comprises a thermo-set polyester with a highly reflective surface, and wherein no additional material is required to provide a highly reflective surface to the substrate; disposing a third material upon the second surface, the second surface being an outer surface; rolling the substrate into a coil; and forming the coil into shapes of individual characters for signs, thereby providing a finished channel letter coil having a reflectivity of above 90% as measured by ASTM International criteria. Instead, as previously pointed out, Benefiel provides a coated veneer to only one surface of a first substrate, the coated veneer to be affixed to a second substrate having substantially the same shape and size as the coated veneer (see Abstract; Fig. 2; Fig. 3; Col. 3, ll. 3-17; Claims). In addition, Benefiel specifically teaches against adding a coated veneer to both surfaces of the substrate, because one of the surfaces is then affixed to a second substrate (Col. 3, ll. 17-19; Fig. 3). Moreover, Benefiel does not teach or suggest forming the coil into shapes of individual characters for signs or of providing a finished channel letter coil having a reflectivity of above 90% as measured by ASTM International. Furthermore, one skilled in the relevant art would not look to Benefiel for a method of making channel letter coil or to produce a channel letter coil composition as disclosed with Applicants' invention. In order to rely on a reference as a basis for an obviousness rejection under 35 U.S.C. 103, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. [e.g., *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992)] Applicants respectfully point out that a problem with which the Applicants were concerned with include to provide "versatile channel letter coil of increased reflectivity that promotes desired illumination, and provides desired aesthetic effects, without requiring the application of additional coating after channel formation." Applicants submit that the Benefiel reference is neither in the field of Applicant's endeavor nor reasonably pertinent to a problem Applicants are concerned with. As stated in Benefiel, the stated purpose is to provide "a method of coating automobile parts which eliminate the need for having a coating process in an OEM assembly plant." Hence, Benefiel not

only discloses an entirely different method and composition, which is a coated veneer for automobiles, which is not in the field of Applicants' endeavor, but the reference is for an entirely different stated purpose. For the above reasons, Applicants submit that the Benefiel reference is unpredictable for Applicants' claimed invention and at least some degree of predictability is required for a showing of obviousness. In addition, Applicants submit that it is not obvious to one having ordinary skill in the art to modify Benefiel in order to provide Applicants' claimed invention, because Benefiel does not teach or suggest most of the required elements of Applicants claimed invention and none of which would be readily apparent to one of ordinary skill when viewing the disclosure provided by Benefiel. Because Benefiel also teaches away from Applicants claimed methods and compositions, there is no suggestion or motivation, either in the Benefiel reference or to one of ordinary skill in the art, to modify Benefiel in order to provide Applicants' claimed invention. For this reason, there is no reasonable expectation of any success or predictability in Benefiel to provide Applicants claimed invention. In view of all factual information, Applicant submits that Claims 37-55, 57-59 and 62, as well as newly entered Claims 63-75, as provided in the Listing of Claims beginning on page 3 of this paper, are not as a whole obvious over Benefiel.

### Conclusion

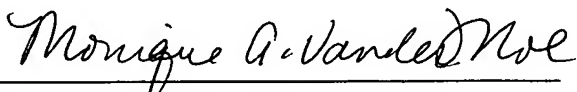
Consideration for and allowance of the pending and new claims in this Application, as provided in the Listing of Claims beginning on page 3 of this paper and pursuant to the filing of this Amendment and a Request for Continued Examination (RCE), are respectfully requested for the reasons set forth herein. In light of the amendments, remarks and arguments presented with this Amendment, Applicants respectfully submit that the pending, amended and new claims are in condition for allowance. No new matter has been introduced with this Amendment. Favorable consideration for and allowance of Claims 37-75 are, therefore, respectfully requested.

Fees for filing a Request for Continued Examination are provided with this paper; no additional fees are believed due with this response. If this is incorrect, the Commissioner is authorized to charge the additional fees, other than the issue fee, that may be required by this paper to Deposit Account No. 07-0153.

If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below.

Dated: May 19, 2006

Respectfully submitted,  
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